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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,953	03/19/2004	Paul C. Blank	11453.00	8082

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/804,953	<b>Applicant(s)</b> BLANK ET AL.	
	<b>Examiner</b> Patricia L. Nordmeyer	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 23, 2006 has been entered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4 – 6, 9 – 11, 16, 19, 23, 27, 28 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Lane (USPN 2,170,147).

Lane discloses a label roll (Figure 2; Page 2, Column 1, lines 48 – 51) comprising web (Figure 1, #10) having a front surface and an opposite back surface wound longitudinally along a running axis (Figure 1, #13) in a roll (Figure 2), said back surface including a plurality of non continuous adhesive patches (Figure 1, #11; Page 2, Column 1, lines 38 – 40) aligned in a column along a running axis of said web in a minor area of said back surface with the remaining

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area of said back surface being devoid of adhesive (Figure 1, #11) and including adhesive-free spaces transversely bridging said web longitudinally between said adhesive patches to isolate said patches in sequential labels and permit cutting of said web in said adhesive-free spaces to separate said labels (Page 2, Column 1, lines 38 – 44) and said front surface including a release strip extending along said running axis behind said column of adhesive patches and laminated to said patches in successive layers in said roll (Page 2, Column 1, lines 44 – 51) with said patches being sized for bonding an individual label to a surface (Page 2, Column 1, lines 70 – 74) in claims 1 and 19. With regard to claims 2, 4 – 6 and 23, the patches are aligned along said one edge of said web, being closer thereto than to an opposite edge of said web, having straight edges aligned parallel and transversely with said running axis forming a rectangular shaped area (Figure 1, #11; Page 2, Column 1, lines 33 – 38). The release strip covers said web front side in full (Page 2, Column 1, lines 44 – 51) as in claim 16. As in claims 9 – 11, 27 and 28, the patches are elongate transverse to said running axis (Figure 1, #11) and devoid of index marks (Figure 1), and each of said labels has a plurality of said adhesive patches (Figure 5, #21). With regard to claim 31, a label comprising a web (Figure 1, #10) wound longitudinally in a roll (Figure 2), said web including a train of longitudinally separated identical adhesive patches aligned in a single column (Figure 1, #11) to define corresponding labels each having a minor adhesive patch isolated inboard in a surrounding adhesive-free remainder of each label (Page 2, Column 1, lines 38 – 40), with said adhesive-free remainder transversely bridging said web longitudinally between said patches to permit adhesive-free cutting of said web to separate said labels (Page 2, Column 1, lines 38 – 44).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 8, 12 – 15 and 17 – 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (USPN 5,578,352) in view of Lane (USPN 2,170,147).

Smith discloses a label roll (Column 1, lines 40 – 43) comprising web (Column 2, lines 54 – 58) that is continuous along said running axis and imperforate (Column 3, lines 6 and 7) having a front surface and an opposite back surface wound longitudinally along a running axis (Figure 2, #13 and 14) in a roll (Column 1, lines 40 – 43), said back surface including a plurality of non continuous adhesive patches (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46) aligned in a column along a running axis of said web in a minor area of said back surface with the remaining area of said back surface being devoid of adhesive (Figure 2, #34 and 35; Column 4, lines 16 – 18) and including adhesive-free spaces transversely bridging said web longitudinally between said adhesive patches to isolate said patches in sequential labels and permit cutting of said web in said adhesive-free spaces to separate said labels (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46, whereby the adhesive-free areas are formed in between the discontinuous strips) and said front surface including a release strip extending along said running axis behind said column of adhesive patches and laminated to said patches in successive layers in said roll (Column 3, lines 42 – 52) with said patches being sized for

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bonding an individual label to a surface (Figure 3, #11) in claims 1, 3 and 19. With regard to claims 4 – 7, 23 and 24, the patches are aligned along said edge of said web (Figure 2, #34 and 35), have straight edges aligned parallel and transversely with said running axis forming a rectangular shaped area (Figure 3) and are elongate along said running axis (Figure 2 and 3).

The web further includes corresponding index marks between adjacent patches to define corresponding labels (Figure 3, #19) as in claims 8, 15, 21 and 25. With regard to claims 17, 18, 22 and 29, the release strip is narrow to conform in width with said column of adhesive patches thereby leaving the remainder of the web front side devoid (Column 3, lines 48 – 42) and is made from a silicone coating (Column 3, line 33). As in claim 28, each of said labels has a plurality of said adhesive patches (Figure 2, #34 and 35). However, Smith fails to disclose the patches being aligned along one edge of said web and closer thereto than an opposite edge of said web, the patches have arcuate edges extending transversely with said running axis, convex leading edges with convex trailing edges connected by straight edges, ovals with major axes disposed parallel to the running axis, the release strip covering said web front in full and the patches being elongate transverse to said running axis.

Lane teaches the patches of adhesive being aligned along one edge of said web and closer thereto than an opposite edge of said web (Figure 1, #11; Page 2, Column 1, lines 33 – 38), the release strip covering said web front in full (Page 2, Column 1, lines 44 – 51) and the patches being elongate transverse to said running axis in a roll of gummed bands or stickers (Page 1, Column 1, lines 1 – 4) for the purpose of being able to cut each band from a coated sheet without

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gumming the cutting knife and with fusing together the edges of the resulting bands (Page 3, Column 1, lines 15 – 20).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a single adhesive patch in an elongate shape in Smith in order to cut each band from a coated sheet without gumming the cutting knife and with fusing together the edges of the resulting bands as taught by Lane since Smith discloses the use of discontinuous strips (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46).

Regarding the patches having arcuate edges extending transversely with said running axis, convex leading edges with convex trailing edges connected by straight edges, ovals with major axes disposed parallel to the running axis, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947), *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the adhesive patch as Smith teaches a variety of shapes being used (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46).

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***Response to Arguments***

6. Applicant's arguments with respect to claims 1 - 29 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

4/17/06